



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,094	05/09/2001	Mark R. Dee	36861.00.0006	5243

7590 09/26/2008
Angelo J. Bufalino
VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LaSalle Street
Chicago, IL 60601

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
----------	--------------

3689

MAIL DATE	DELIVERY MODE
-----------	---------------

09/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/853,094	Applicant(s) DEE, MARK R.	
	Examiner Dennis Ruhl	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 105-115 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 105-115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/08 and 6/16/08 has been entered. The examiner will address applicant's remarks at the end of this office action.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 105-115, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claim 105, the examiner notes the language of the last paragraph "wherein the communication means provides the central processing with....billing database", and "wherein the communication means number and....are activated and recorded in the central database.....is charged for parking by the central processing means" is directed to recitations of how the claimed system is being used and how it executes a method. This is claiming method steps in an apparatus type of claim. Also, the language of "the reference identifier moved into said parking space where the vehicle is parked and displayed on the vehicle at the parking space" is also directed to a method step of using the recited structure of the system. This language is not written in a functional sense and seems to be reciting that the communication means is actually performing the

Art Unit: 3689

recited steps and that the claim is reciting that the reference identifier is being moved and displayed on the vehicle. This is improper because a claim can only fall into one statutory class of invention at one time. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

For claims 107-115, applicant is reciting further method steps of using the recited structure of the system. This is improper because a claim can only fall into one statutory class of invention at one time. These claims are dependent from an apparatus claim but are reciting method steps using recited structure of the system, which is a mixing of two distinct statutory classes of invention. This renders the claims as non-statutory in the same manner as claim 105. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 105-115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 105-115, one wishing to avoid infringement would not know the scope of the claim. The reason is that one wishing to avoid infringement would not know whether or not they were infringing by just possessing the claimed structure of the

Art Unit: 3689

invention, or if they were infringing only when using the claimed device in the claimed manner (as has been addressed in the 101 rejection). The claim is indefinite for this reason. Correction is required. Ex parte Lyell 17 USPQ2d 1548 (Bd. Pat. App. & Int 1990) ; IPXL Holdings, L.L.C. v Amazon.Com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005).

For claim 106, what is meant by reciting that the reference identifier is a pass number? This does not make any sense. The reference identifier is claimed as having wireless communication means in claim 105 so how can a number satisfy this language? A number is a number and it is not capable of communicating wirelessly with any other device. Also, a number is not a real world tangible thing that can constitute an element of structure in an apparatus type of claim. The language of claim 105 regarding the reference identifier is what has been considered with respect to prior art due to the indefiniteness of claim 106.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 105-115, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet et al. (WO 97/37328) in view of Zeitman (WO 98/04080) and further in view of Maropis et al. (20020061092).

For claims 105,106, Ouimet discloses a parking payment system. There is inherently a vehicle, a space and a location as claimed. The claimed reference identifier is considered to be the motorist "smart card" that is disclosed by Ouimet on page 6; however, it is not disclosed that the motorist smart card has wireless communication means as is claimed in claim 105. The wireless ticket issuance device is 18, and communicates with a central processing means 16. The parking meter is 12 and has wireless communication means 41. The parking meter and the central processing means can credit the central processing means with payment received as claimed. The central processing means (computer 16), tracks credits for payment received as claimed, records start times for parking (so you can determine when a vehicle is illegally parked due to exceeding the time paid for parking), communicates status information to the wireless ticket devices 18, and records ticket information as claimed.

Not disclosed is that there is a communication means to be used by the occupant to communicate with the central processing means. Also not disclosed is that the motorist smart card (from pg 6 of Ouimet) has wireless communication means as is claimed in claim 105. Also not disclosed is that the system is able to inform and prompt the communication means, upon expiration of time, to enter more time to credit the parking meter.

With respect to the smart card having wireless communication means, one of ordinary skill in the art would clearly recognize that smart cards can either be contact type or non contact type. The examiner takes "official notice" that it was well known in

Art Unit: 3689

the prior art to use contactless type smart cards (with wireless communication means) in addition to using contact type of smart cards. Both were known in the art prior to the filing of the instant application. The examiner has previously cited examples of evidence that supports this position in a previous office action and this issue is now settled as a matter of fact on the record. Taking into account that Ouimet discloses the use of a smart card (may be contactless or contact type, nothing further disclosed by Ouimet) and taking into account that one of ordinary skill in the art at the time the invention was made would have been aware of and understood the fact that smart cards also come in a contactless type that has wireless communication means, one of ordinary skill in the art would have found it obvious to use a smart card that has wireless communication means as an alternate to the contact type of smart card used in Ouimet. Both types of smart cards were known in the art and to simply use a contactless type of smart card is something that one of ordinary skill in the art would have understood and would have found obvious. A reason for doing this would be for the advantages that having wireless devices provides. They are easier to use in that they communicate data wirelessly. One of ordinary skill in the art would have clearly appreciated the desirability of using a smart card with wireless communication means as is claimed.

Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone or a computer, and can provide the information such as vehicle space and time information by using their telephone. This would allow for more user convenience when conducting the parking space use

Art Unit: 3689

transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by a communication means (telephone, computer) as is disclosed by Zeitman so that the user has another convenient method by which to conduct the parking transaction.

With respect to the last paragraph of claim 105, this paragraph is directed to method limitations that are not seen as defining any further structure to the claimed system. Also, these recitations are directed to non-functional descriptive material anyway, because the recited data is claimed as being sent but is never recited as being able to be used in any further manipulative manner. The language of "for association" is not seen as a further manipulative use of the data (this would have to be written in a functional sense anyway and not as actual method steps). The number or password, etc. is directed to non-functional descriptive material.

With respect to the language of "and to register...processing means", this is directed to the intended use of the communication means and is not a further recitation to any structure that is not found in the prior art. With respect to the limitation of "the reference identifier moved into said parking space where the vehicle is parked and displayed on the vehicle at the parking space", this is directed to a method step and does not result in any additional structure to the system being recited. While the examiner believes that this is directed to a method step, another way to look at it is that this is positively reciting the intended use of the structure of the system and is not a further recitation to any structure that is not found in the prior art.

With respect to the ability to inform and prompt the communication means to enter more time, Maropis discloses a system that can inform and prompt a customer of the impending expiration of a service. A customer is disclosed as being informed of the expiration of a service so that they can renew their service. The prompting can be done by calling the customer's telephone and can be done at any time as requested by the customer, see paragraph 25. This is a teaching that it is desirable to remind and inform people about an upcoming expiration of a service, so that they can take the appropriate steps to ensure continued service. This teaching is applicable to and desirable for many types of situations where a service of some kind is about to expire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Ouimet with the ability to inform and prompt the communication means of user (which is a telephone) of the fact that their time is about to expire, so that they can add more time to avoid getting a parking violation (ticket). The combination with Zeitman already has resulted in the ability to add or credit the parking meter with time so this part of the claim language is satisfied by the prior art. With respect to the fact that the claim recites informing and prompting "upon expiration", this would also have been obvious to one of ordinary skill in the art. Maropis discloses the informing and prompting before expiration and one of ordinary skill in the art would have also found it obvious to do the informing and prompting step upon expiration as this is the point at which the service (paid parking time) has ended. Informing the user before expiration is more desirable but informing upon expiration is also considered to be obvious in view of the prior art teaching.

For claims 107-115, these claims recite nothing more than method steps and this is not seen as defining any further structure to the claimed system. This language is not written in a functional sense as far as what an element of the system is programmed or configured to do, it is written as if the claims are method claims which they are not. This defines no further structure to the system that is claimed. Structure to a system is what is given weight in apparatus claims, not recitations directed to method steps of using the recited structure.

8. Applicant's arguments filed 6/13/08 have been fully considered but they are not persuasive.

The examiner notes that in the initial RCE filing, applicant presented a very brief argument for method claim 92, which was essentially just restating what was claimed with no real comparison or explanation as to how this defines over the closest prior art. The arguments in the RCE filing are taken as nothing more than mere allegations of patentability due to their lack of an explanation. In response to the notice of non-responsive amendment dated 5/16/08, applicant canceled method claims 92-104 and presented new system claims 105-115, which are currently pending. In the most recent response applicant has argued that they have provided novelty support in the RCE filing of 2/28/08. The arguments presented in the RCE filing do not relate to the instant pending claims. The arguments made for the previous set of method claims does not apply to the currently pending claims, so the reference to the RCE filing is not taken as any kind of argument for patentability because the arguments are not commensurate

Art Unit: 3689

with the scope of the currently pending claims and do not address the closest prior art of record. Also, even when considered, the previous arguments were just general allegations of patentability so there is really nothing there for the examiner to respond to. Applicant has also stated that they are of the opinion that previous claim 50 was allowable for reasons articulated before (unclear as to when and what arguments are being referred to). Applicant has stated that the claims are allowable for the same reasons incorporated herein. This is not a specific showing of what the actual argument is that the applicant wants the examiner to consider. The examiner has no idea what arguments applicant is referring to. In the Final rejection of 11/28/07, the examiner addressed previous claim 50 and since that time, there has been no argument on the record that addresses the new language that is currently found in claim 105, and that applicant states is the additional language from the previous version of claim 50. With respect to the new language that applicant states is in claim 105, and that was added to the previous version of claim 50, it has never been addressed. On page 8 applicant shows the examiner how new claim 105 compares to the previous version of claim 50 but applicant has not addressed the language that applicant has stated is new from the previous version of claim 50 (now drafted as new claim 105). The examiner does not see any new argument that has been presented by applicant. The rejection is deemed to be proper.

9. This is an RCE of applicant's earlier Application No. 09/853094. All claims are drawn to the same invention claimed in the earlier application and could have been

Art Unit: 3689

finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3689

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689